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Onyx Dkt No. 1046/O.US
USSN: 09/410,462
PATENT

CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)
I hereby certify that this correspondence is being facsimile transmitted to the Commissioner for Patents, United States Patent and Trademark Office, (Fax No. 703-872-9306) on the date indicated.

Gary K. Fabroin
Signature

20 June 2005

Date of Transmittal

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Williams, A., et al.	Confirmation No. 6889
Serial No.: 09/410,462	Art Unit: 1635
Filing Date: 1 October 1999	Examiner: J.E. Angell
Title: A SINGLE AGENT METHOD FOR KILLING TUMOR AND TUMOR ASSOCIATED ENDOTHELIAL CELLS USING ADENOVIRAL MUTANTS	

TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing in the above-referenced application are the following documents:

1. Transmittal;
2. Response to Final Rejection and Amendment, including complete listing of the claims; and
3. Certificates of Transmission by Facsimile.

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Authorization to Charge Deposit Account: Previous to the accompanying amendment, fees for 28 claims including six independent claims were paid. In the previous amendment two independent claims were canceled. In the present amendment the six claims that were dependent on the canceled claims 21 and 25 are amended to include the limitations of the independent claims from which they were originally dependent.

Accordingly, four independent claims beyond the number of claims originally paid for in the application are added by the amendment in this paper. The Commissioner is hereby authorized to charge to Deposit Account No. 15-0615 a total of \$400.00 (for four independent claims, at small entity rate) with reference to Onyx Dkt. No. 1046/O.US.

No additional fees are believed due. However, the Commissioner is hereby authorized to charge to Deposit Account No. 15-0615 any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, with the exception of the payment of the Issue Fee.

Respectfully submitted,

Dated: 20 June 2005

By: Gary R. Fabian
Gary R. Fabian (Reg. No. 33,875) for
Gregory Giotta, Ph.D., Esq.
Registration No 32,028
ONYX Pharmaceuticals, Inc.

ONYX Pharmaceuticals, Inc.
2100 Powell Street
Emeryville, CA 94608
Phone: (510) 597-6502
Facsimile: (510) 597-6610

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ONYX Pharmaceuticals, Inc.
2100 Powell Street
Emeryville, CA 94608
Phone: (510) 597-6502
Facsimile: (510) 597-6610

CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Technology Center 1600 (703-872-9306) on the following date.

on Monday, June 20, 2005

Total Number of Pages Including Cover Sheet: 26 (twenty six) 947 6/20/05

The following documents are attached:

1. Transmittal;
2. Response to Final Rejection and Amendment, including complete listing of the claims; and
3. Certificates of Transmission by Facsimile.

Gary R. Fabian 6/20/05
Signature

Gary R. Fabian
Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

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CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)

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Gary K. Fabrian
Signature

20 June 2005

Date of Transmittal

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Williams, A., et al.	Confirmation No. 6889
Serial No.: 09/410,462	Art Unit: 1635
Filing Date: 1 October 1999	Examiner: J.E. Angell
Title: A SINGLE AGENT METHOD FOR KILLING TUMOR AND TUMOR ASSOCIATED ENDOTHELIAL CELLS USING ADENOVIRAL MUTANTS	

RESPONSE TO FINAL REJECTION AND AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the final Office Action in the above-referenced application, mailed 20 April 2005. This response is being filed within TWO MONTHS of the mailing date of the final Office action (i.e., 20 June 2005). An authorization to pay for four additional independent claims (\$400 at small entity rate) accompanies this paper. No additional fee is believed due; however, the Commissioner is hereby authorized to charge to Deposit Account No. 15-0615 any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, with the exception of the payment of the issue fee. Reconsideration of the application in view of the following amendments and remarks is respectfully requested.

Applicants submit that the present amendment conforms to the revised amendment format requirements. If there are any problems with the format of applicants' amendment, the Examiner is respectfully requested to contact Gregory Giotta, Ph.D., at (510) 597-6502.

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Introductory Comments

I. Summary of the Office Action.

In the final Office action, dated 20 April 2005, claims 1-20, 22-24, and 26-28 have been rejected for the following reasons.

The Examiner maintained the rejection of claims 1-20 under 35 U.S.C. §112, first paragraph, asserting that the specification, "while being enabling for methods of reducing the size of a tumor by the intratumoral injection of Ad5 vector disclosed as dl922/947, dl1107 or pm 928, does not reasonably provide enablement for the full scope of the claims."

The Examiner maintained the rejection of claims 1-6 under 35 U.S.C. §102(e) asserting that the claims are anticipated by Bischoff, et al. (U.S. Patent No. 6,080,578).

The Examiner rejected claims 22-24 and 26-28 under 35 U.S.C. §112, second paragraph, asserting that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

These rejections are believed to be overcome in part by the amendments and are otherwise traversed for reasons discussed below.

In the final Office action, dated 20 April 2005, the Examiner has withdrawn the following rejections.

The Examiner has withdrawn the rejection of claims 6 and 7 under 35 U.S.C. §112, second paragraph (see, final Office action, dated 20 April 2005, page 8).

The Examiner has withdrawn the rejection of claims 21-28 under 35 U.S.C. §112, first paragraph, "as claims 21 and 25 have been cancelled" (see, final Office action, dated 20 April 2005, page 8).

The Examiner has withdrawn the rejection of claims 21 and 22 under 35 U.S.C. §102(b) as being anticipated by Yamashita, T., et al. (Oncogene (1993) 8:2433-2441) "because claim 21 and 25 have been cancelled" (see, final Office action, dated 20 April 2005, page 8). Applicants note that in the original rejection under 35 U.S.C. §102(b), set forth in the Office action dated 17 January 2002, claim 25 was not rejected. Accordingly, applicants respectfully request clarification regarding the Examiner's reason for withdrawal of the rejection "because claim 21 and 25 have been cancelled."

The Examiner has withdrawn the rejection of claims 21, 23, and 24 under 35

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U.S.C. §102(b) as being anticipated by Shisler, J., et al. (Journal of Virology, Jan. 1996, pages 68-77) "because claim 21 and 25 have been cancelled" (see, final Office action, dated 20 April 2005, page 8). Applicants note that in the original rejection under 35 U.S.C. §102(b), set forth in the Office action dated 17 January 2002, claim 25 was not rejected. Accordingly, applicants respectfully request clarification regarding the Examiner's reason for withdrawal of the rejection "because claim 21 and 25 have been cancelled."

The Examiner has withdrawn the rejection of claims 21 and 25 under 35 U.S.C. §102(e) as being anticipated by Bischoff, et al. (U.S. Patent No. 6,080,578) "as claims 21 and 25 have been withdraw [sic]" (see, final Office action, dated 20 April 2005, page 8).

The Examiner has withdrawn the rejection of claims 1-10 and 21-28 under 35 U.S.C. §103(a) over Bischoff (cited above) in view of Yamashita, T. (cited above), or Shisler, et al. (cited above) because "of the Applicants arguments with respect to the secondary reference(s)" (see, final Office action, dated 20 April 2005, page 8).

II. Overview of the Amendments.

Claims 1-20, 22-24, and 26-28 are pending in the application. Claims 22-24 and 26-28 are amended without prejudice or disclaimer. Amendment of these claims is not intended to be an acquiescence in the Office's assessment of those claims in the final Office action, dated 20 April 2005, and applicants expressly reserve the right to bring the subject matter of the original claims again in a subsequent, related application. After entry of this amendment claims 1-20, 22-24, and 26-28 are pending in the application.

The amendments to the claims are presented herein below (after the signature page) in the section titled "Amendments to the Claims."

Support for the amendment to claims 22-24 can be found throughout the specification, for example, at the following locations: originally presented claim 21.

Support for the amendment to claims 26-28 can be found throughout the specification, for example, at the following locations: originally presented claim 25.

Accordingly, no new matter has been added by way of this amendment and the entry thereof is respectfully requested.

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III. Payment for Additional Claims

Previous to the present amendment, fees for 28 claims including six independent claims were paid. In the previous amendment two independent claims were canceled. In the present amendment the six claims that were dependent on the canceled claims 21 and 25 are amended to include the limitations of the independent claims from which they were originally dependent. Accordingly, four independent claims beyond the number of claims originally paid for in the application are added by the amendment in this paper.

Accompanying this paper is an authorization to charge Deposit Account No. 15-0615 for four independent claims, at small entity rate, for a total of \$400.00.